

#### REMARKS

Claims 2-20 remain for consideration. Claim 1 is canceled without prejudice. Applicants acknowledge with appreciation the allowability of claims 17-20 over the prior art. The specification was amended to add the application number of an commonly owned application filed on the same day as the present application. Applicants have amended claims 5, 6 and 16 to more particularly point out their invention. In particular, claim 5 was amended to correct an antecedent reference. The amendment to claim 6 is supported by the specification, for example, at page 7, lines 10-13 and from page 8, line 34 to page 9, line 5 and Fig. 7. The amendment to claim 16 is supported by the specification, for example, from page 2, line 32 to page 3, line 2. No new matter is introduced by any of the amendments.

Applicants respectfully request reconsideration of the rejections based on the following analyses.

#### Objection to Specification

The Examiner objected to the specification for not listing the application number of a referenced, commonly assigned patent application filed on the same day as the present application. Applicants have updated this information. Applicants respectfully request withdrawal of the objection to the disclosure.

#### Claim Objections

The Examiner objected to the claims for lack of a proper antecedent reference in claims 5 and 6. This informality has been corrected. Applicants respectfully request withdrawal of the objection to the claims.

#### Rejections Under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 6-8 as being indefinite. In particular, the Examiner indicated that there is an inconsistency between claim 8 and claims 2 and 6. Applicants have amended claim 6 for clarity by indicating the orientation of the pads. Specifically, Applicants note that the conductive pads extend from

the bottom (air bearing surface) to the top surface of the slider/head. Thus, the pads provide electrical conduction from the air bearing surface, where the thermal transducer(s) is located, to the top surface of the slider/head and subsequently to an appropriate measurement device. This structural relationship can be seen in Fig. 7. with pads 408, 410 extending along the edge of the slider. See also the description, for example, at page 7, lines 10-13. As amended, Applicants believe that the claims are clear. Applicants respectfully request withdrawal of the rejection of claims 6-8 as being indefinite.

Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1 and 16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,808,184 to Boutaghou et al. (the Boutaghou patent). Claim 1 has been canceled without prejudice. Thus, the rejection of claim 1 is presently moot. With respect to claim 16, the Examiner indicated that the method would be practiced in the normal production process of the Boutaghou device. Applicants have amended claim 16 to more particularly point out their invention. Applicants respectfully request reconsideration of the rejection of claim 16 based on the following comments.

Applicants have amended claim 16 to indicate that the thermal transducer is a generally planar transducer, which is oriented along the air bearing surface. The Boutaghou patent does not disclose a generally planar thermal transducer oriented along the air bearing surface. Therefore, the Boutaghou patent does not anticipate claim 16.

Applicants respectfully request withdrawal of the rejection of claims 1 and 16 under 35 U.S.C. §102(b) as being anticipated by the Boutaghou patent.

Rejection of Claims 2-11 and 13-15 Under 35 U.S.C. §103

The Examiner rejected claims 2-11 and 13-15 under 35 U.S.C. §103(a) as being unpatentable over the Boutaghou patent in view of

U.S. Patent 5,689,064 to Kennedy et al. (the Kennedy patent). The Examiner cited the Kennedy patent for disclosing a generally planar transducer and electrically conductive pads. The Examiner took Official Notice with respect to several other claimed features. Applicants respectfully request reconsideration of the rejection of claims 2-11 and 13-15 based on the following comments.

The Kennedy patent discloses a generally planar **piezoelectric** transducer (70) located **between the top surface** of the slider and tongue 44. See column 6, lines 54-58 of the Kennedy patent. Tongue 44 is part of flexure 30. **The Kennedy patent does not teach or suggest a thermal transducer or a generally planar transducer oriented along the air bearing surface.** Applicants' claim 2 indicates that the thermal transducer is a generally planar structure oriented along the air bearing surface. Since neither the Boutaghou patent nor the Kennedy patent teach or suggest a generally planar transducer **oriented along the air bearing surface**, the combined disclosures of the Boutaghou patent and the Kennedy patent do not render Applicants' claimed invention obvious. In addition, some of the other claimed features not disclosed by the Boutaghou and Kennedy patents have significant contributions to the performance of the device.

Applicants respectfully request the withdrawal of the rejection of claims 2-11 and 13-15 under 35 U.S.C. §103(a) as being unpatentable over the Boutaghou patent in view of the Kennedy patent.

#### Rejection of Claim 12

The Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over the Boutaghou patent and the Kennedy patent as applied to claims 2-11 and 13-15, and further in view of U.S. Patent 5,423,207 to Flechsig et al. (the Flechsig patent). The Examiner cited the Flechsig patent for disclosing the grounding of a sensor. Applicants respectfully request reconsideration of the rejection of claim 12 based on the following comments.

The Flechsig patent describes a piezoelectric transducer mounted on the top surface of a slider. As with the Kennedy patent, the Flechsig patent does not teach or suggest a thermal transducer or a transducer oriented along the air bearing surface. Therefore, the Flechsig patent does not make up for the deficiencies of the Boutaghou patent and Kennedy patent with respect to rendering claim 2 obvious. Therefore, the combined disclosures of the Boutaghou patent, the Kennedy patent and the Flechsig patent do not render claim 12, which depends from claim 2, obvious. Applicants respectfully request the withdrawal of the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over the Boutaghou patent and the Kennedy patent as applied to claims 2-11 and 13-15, and further in view of the Flechsig patent.

CONCLUSIONS

In view of the above amendments and remarks, Applicant submits that this application is in condition for allowance, and such action is respectfully requested. The Examiner is invited to telephone the undersigned attorney to discuss any questions or comments that the Examiner may have.

The Director of the Patent and Trademark Office is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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